

REMARKS

The Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the reasons that follow.

I. Status of the Claims

Claim 2 is combined into independent claim 1 such that claim 1 recites that R¹ is a 2-ethylhexanoic acid residue and R² is a benzoic acid residue. Claim 2 is accordingly cancelled. The Applicants reserve the right to pursue the subject matter of the cancelled claim in a continuation application. Claim 7 as amended is an independent claim incorporating some of the recitations from claim 1. Claim 6 is amended to change its dependency. New claims 8 and 9 are added to recite specific embodiments of claims 1 and 7, respectively; support therefor can be found in, *inter alia*, lines 11 – 19 on p. 2 and Table II on p. 8, of the Specification as filed. No new matter is introduced, and claims 1 and 3-9 are currently pending to be examined on their merits.

The Applicants respectfully submit that there appears to be a typographical error on the Office Action Summary page, which indicates that claim 13 is objected to.

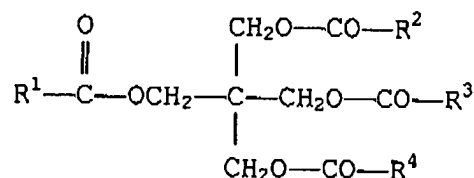
II. Claim Rejections – 35 U.S.C. § 103

Claims 1-3 and 6-7 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over WO 02/19977 A1 (“Mitsumatsu”), and claims 4-5 are rejected under 35 U.S.C. § 103(a) over Mitsumatsu, in view of WO 00/26285 (“Healy”). The Applicants respectfully traverse these rejections.

(i) The presently claimed compositions indeed provide unexpected results over the prior art teachings

While not acquiescing to the grounds of the rejections, independent claims 1 and 7 are amended, and claims 1 and 7 now recite that R¹ is a 2-ethylhexanoic acid residue. At the outset, the Applicants respectfully traverse the Office's position that the present claims are only limited to lipsticks. As provided in the present Specification, the presently claimed compositions can be used in lipsticks, eye shadow cosmetic, hair cosmetic, etc. (See Specification, p. 2), and the Hosokawa Declaration was submitted merely to illustrate the unexpected superior results obtained in certain embodiments of the presently claimed compositions. In addition, as a result of the amendments, the Applicants respectfully submit that the unexpected results presented are indeed commensurate in scope with the present claims.

As the Applicants already showed via the Hosokawa Declaration, a composition containing the specific residue as recited in the present claims can provide unexpected superior results. Specifically, Mitsumatsu discloses a hair care composition comprising a pentaerythritol ester oil having the formula:



which is similar to those of the compounds described in Examples 1 and 2 and Comparative Example 1 of the present application. However, as shown in Example 1 and Comparative Example 1 in Tables I-II of the present Specification and the Hosokawa Declaration, only the use of **tribenzoic acid ester** (see Examples 1 and 2) and the use of **dibenzoic** acid ester (see Experiments A and B in the Declaration) can provide the desired results. By contrast, **tetra-2-ethylhexanoic acid ester** does **not** provide these desired results.

This stark contrast further demonstrates that the Office is incorrect to assert that merely because Mitsumatsu generally discloses pentaerythritol ester oil having a formula similar to those of the compounds used in Examples 1 and 2, one would reach the presently claimed compositions and its surprisingly superior results based on Mitsumatsu's teachings. In fact, as shown in the previous replies and the Declaration, for the desired results (i.e., gloss on lips, moisture feeling, and cosmetic durability) to be obtained, **the pentaerythritol ester must have two or three benzoic acid residues**, as shown in the formula (I) in the present claims; see Examples 1 and 2 and Experiments A and B in the Hosokawa Declaration. Such a property is unpredictable to one of ordinary skill in the art in view of Mitsumatsu's teachings. In fact, nowhere can this be found in Mitsumatsu.

(ii) *The Office's interpretation of the Hosokawa Declaration is improper*

The Office does not find the results provided in the Hosokawa Declaration persuasive because the Office alleges that (a) the results are based on opinion and (b) the results do not seem to be unexpected enough – "...based on a difference of 1 person.." Office Action, p. 3. The Applicants respectfully submit that the Office's interpretation of the Hosokawa Declaration is improper.

At the outset, the Applicants respectfully submit that the Office is incorrect to compare the unexpected results presented in the Hosokawa Declaration and the teachings of "Mitsumatsu et al. in view of Healy et al. because the combined teaching suggest ..." Office Action, p. 6. As stated in MPEP § 716.02(e) III, the unexpected results presented should not be compared to combined teachings; rather, they must be compared to those of the single closest prior art (stating that evidence of unexpected results must compare the claimed invention with the closest prior art). Thus, the Office's comparison of the unexpected results obtained via the presently claimed compositions to the combined teachings of Mitsumatsu and Healy is improper.

(a) The presented data are measurements based on objective standards

The Applicants traverse the Office’s assertion that because the results are “based on opinion... proper analysis cannot be done on opinion.” Office Action, p. 3 and p. 6. While the rating was not provided in terms of a unit measurement, such as length or mass, each of the ratings is an experimental data point obtained based on an objective standard and obtained as objective reproducible information. Further, the Applicants traverse the Office’s dismissal of the validity of the presented results merely because they are based on judgments of members of a panel, particularly when the judgment is a purely binary “good/no-good” response. Scientific data are frequently based on human perception (e.g., a pathologist’s interpretation of a histology diagram), and the mere fact that they are obtained from a perception does not automatically render them not objective, especially when the evaluation is obtained via an objective standard.

This is particularly true when the evaluation requires only a binary determination – i.e., “good” or “not good.” The Applicants respectfully submit that the numerical values presented in Table II of the Specification are not based on one person’s evaluation on a 1-10 scale; namely how “good” he/she feels. Rather, the data are based on **binary** evaluations of 10 people pooled together, and each value represents the number of people that deem a certain property to be “good.” As a merely illustrative example, while the observation of a cracked flower pot (as opposed to an intact flower pot) is based on an “opinion, (i.e., “the pot is cracked and thus it is not good”), the observation serves to distinguish an intact flower pot (“it is a good pot”) and its associated properties from a cracked flower pot (“it is not a good pot”). The Specification has established objective criteria to evaluate the properties of the presently claimed compositions. Thus, the Applicants respectfully submit the presented data were obtained based on objective criteria and the merits of the data should be treated accordingly.

(b) The “unexpectedness” of the results is significant

The Applicants traverse the Office’s apparent position that because the unexpected results are “based on a difference of 1 person in the comparison...” the results are not sufficiently unexpected. At the outset, the Applicants respectfully direct the Office’s attention to the evaluation criteria as established on p. 7 of the present Specification. As shown on p. 7, B” refers to “6 or more...but less than 8” and “C” refers to “4 or more...but less than 6.” Accordingly, in principle, B can be based on as many as 7 and C can be based on as few as 4, resulting in a difference of 3, instead of just “1.” As a result, the Office’s interpretation of the data is incorrect. In fact, the Applicants provide in the Appendix of this reply the number of judges on the 10-person panel in each of the evaluations as provided in the Specification and in the Declaration. As shown in the Table in the Appendix, a difference between B and C can be as large as “3,” instead of what the Office would perceive as “1” (see e.g., Ex. A and Comparative Ex 1 with respect to “Moisture Feeling.”)

Moreover, regardless of the magnitude of the difference, be it a 1 or a 3, in line with the reasons as set forth above, the Applicants further respectfully submit that the magnitude should not be used as an indicator of how “unexpected” the results are. Whether the magnitude is 1 or 3, the Office has provided no evidence to indicate such a result would have been expected based on the claimed structure.

In sum, the Applicants respectfully submit that the Hosokawa Declaration and the previously filed replies have demonstrated results with respect to the presently claimed compositions that are indeed unexpected over the teachings of the prior art. Thus, the Applicants reiterate that such unexpected results rebut any *prima facie* case obviousness.

Therefore, at least in view of the foregoing, the Applicants respectfully request that the rejections be withdrawn.

APPENDIX

	Exp. A		Exp. B		Ex. 1		Ex. 2		Comp. Ex. 1		Comp. Ex. 2	
	*1	*2	*1	*2	*1	*2	*1	*2	*1	*2	*1	*2
Ease of Application	B	7	B	7	B	6	B	7	B	6	B	6
Stickiness	B	6	B	6	B	6	B	5	B	6	B	6
Gloss of Lips	B	7	A	9	B	7	A	10	D	0	C	5
Moisture Feeling	B	7	A	10	B	7	A	10	C	4	C	5
Cosmetic Durability	A	9	A+	10	B	7	A	9	C	4	C	4

- *1: Evaluation Criteria shown in Table II of the present specification and “Table” in the previously filed Hosokawa Rule 132 Declaration
- *2: The number of the persons or members) of a 10-member panel, who judged “good” in the evaluations for “Ease of Application”, “Stickiness”, “Gloss of Lips”, “Moisture Feeling” and “Cosmetic Durability” in Table II of the present specification and “Table” in the Rule 132 Declaration.

From the above results, we believe that the superiority of "Gloss of Lips", "Moisture Feeling" and "Cosmetic Durability" of Experiments A and B and Examples 1 and 2 over those of Comparative Examples 1 and 2 are clear. Namely, the actual differences of the number of judges finding results good compared to the number of judges finding the results not good in the Experiments and Examples 2 is significant.

CONCLUSION

The Applicants believe that the present application is now in condition for allowance and respectfully request favorable reconsideration of the application.

The Office is invited to contact the undersigned by telephone if a telephone interview would advance the prosecution of the present application.

The Office is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, the Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By Stephen B. Maebius

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5569
Facsimile: (202) 672-5399

Stephen B. Maebius
Attorney for the Applicants
Registration No. 35,264